

Commissioner for Patents

## REMARKS

Claims 3 and 5-8 remain in the application.

On page 2 of the Office Action, the Examiner identifies informalities, and rejects claim 3 under 35 U.S.C. 112. Hence, claims 3 and 7 are amended in accordance with the Examiner's suggestions.

On page 6 of the Office Action, the Examiner provides a response to arguments. According to the Examiner, the Applicants' arguments "are not persuasive". Therefore, the rejection of the claims on file under 35 U.S.C. 103(a) as being unpatentable over the combination of Brosseau and Ellis stands.

Claim 3 as previously presented comprises a computer-assisted surgery system "*digitizing an intramedullary canal of the bone from the orientation of the apparatus when the fingers are actuated into contacting the surface of the intramedullary canal*". **This limitation is not taught by Brosseau.**

The Examiner states that "*the computer-assisted surgery system (10) [of Brosseau] is capable of digitizing an intramedullary canal of the bone from the orientation of the apparatus*".

Firstly, Brosseau does not teach the apparatus, as acknowledged by the Examiner. Without teaching such an apparatus, Brosseau does not describe any tool that can be used to digitize the intramedullary canal. Secondly, Brosseau does not discuss the intramedullary canal of the tibia. Accordingly, the statement that Brosseau is "capable of" digitizing the intramedullary canal is unsupported by documentary evidence.

As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the Examiner must be "*capable of such instant and unquestionable demonstration as to defy dispute*". Moreover, according to MPEP 2144.03, "*it would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known.*"

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The limitation identified above is not taught by either one of Brosseau and Ellis, whereby the rejection under 35 U.S.C. 103(a) is improper.

Claim 3 as previously presented comprises a user interface “*outputting data related to the axis of the intramedullary canal from the tracking of the detectable device and from the digitization of the intramedullary canal*”. **This limitation is not taught by Brosseau.**

The Examiner states that “*the display monitor (18, Figs. 1 and 3) [of Brosseau is] capable of outputting data related to the axis of the intramedullary canal*”. However, Brosseau does not specify at any point that data pertaining to the axis of the intramedullary canal can be displayed.

Again, *In re Ahlert* and MPEP 2144.03 are cited.

The limitation identified above is not taught by either one of Brosseau and Ellis, whereby the rejection under 35 U.S.C. 103(a) is improper.

As per In Re Royka, each claim feature must be present (i.e., taught or suggested) by an asserted combination for a *prima facie* case of obviousness to be established. The Applicants have identified two limitations of claim 3 absent from both Brosseau and Ellis. As no *prima facie* case of obviousness has been established, claim 3 is deemed to comply with 35 U.S.C. 103(a).

In view of the above amendments and remarks, this application is considered to be in condition for allowance, and early notice to that effect is earnestly solicited.

Respectfully submitted,  
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By:

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January 10, 2012

(Date)

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